

USSN 10/731,854

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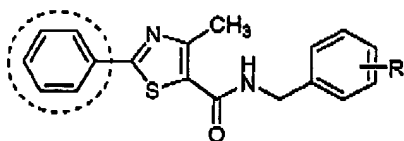
Remarks

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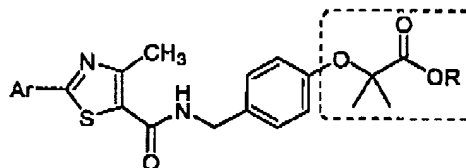
**Status of the claims.** Claims 1 and 3-17 are pending. Claim 2 has been cancelled. Claims 12-17 were withdrawn from consideration by the examiner. Claims 1 and 3-11 were rejected under 35 USC 103(a).

**Rejection under 35 USC 103(a).** The examiner rejected claims 1 and 3-11 as obvious over Akiyoshi et al. (JP4-128275) in view of Sierra (US 6,518,290). The applicants respectfully traverse.

Akiyoshi teaches a group of compounds having insecticidal activity (please refer to machine translation provided in Supplemental IDS). Examples 10 and 11 teach a phenyl substituent corresponding to  $Ar^1$  in the claimed compounds. Sierra teaches a series of compounds having human peroxisome proliferator activated receptor activity (PPAR). Sierra teaches 57 examples which all have a para substituted gem-dimethyl glycolic acid/ester moiety.



Akiyoshi Examples 10 and 11



Sierra: all 57 examples

To establish a prima facie case, the examiner must show some motivation or suggestion to make the claimed compounds. *In re Brouwer*, 77 F.3d, 422, 425, 37 USPQ2d 1663 (Fed. Cir. 1996). Akiyoshi teaches that compounds with a phenyl substituent on the thiazole ring are active, but because of the well known unpredictability of biologically active compounds, does not teach or fairly suggest that compounds with additional substituents on the phenyl ring would be active. It is not clear that Akiyoshi even generically embraces substituted phenyl substituents (at least our machine translation merely mentions phenyl and not substituted phenyl). But even if it did, a genus does not render subgeneric classes or species prima facie obvious. *In re Balrd*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994). The mere fact that the prior art can be modified to arrive at the claimed compounds is insufficient to establish a prima facie case of obviousness. *In re Fritch*, 972 F.2d 1266, 23 USPQ 1780 (Fed. Cir. 1992).

The claimed compounds require that when  $Ar^1$  is a phenyl ring, it must be substituted (that is,  $R^4$  is a substituent other than hydrogen). In contrast, Akiyoshi merely teaches that phenyl compounds have insecticidal activity and does not teach or fairly suggest if any compounds with substituted phenyl moieties would be active. As such, it does not establish a prima facie case of obviousness.

Likewise, Sierra teaches a series of 57 compounds all of which contain a para substituted gem-dialkyl glycolate which is disclosed as necessary for PPAR activity. Sierra does not teach or fairly suggest that

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compounds without this moiety or with other moieties would possess PPAR activity, nor does the patent claim compounds without this moiety.

None of the claimed compounds contain a para substituted gem-dialkyl glycolate moiety or any art-recognized equivalent substituent which would convey PPAR activity. As such, Sierra does not suggest the claimed compounds and does not establish a prima facie case of obviousness.


Furthermore, the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 916 F.2d 680 16 USPQ2d 1430 (Fed. Cir, 1990). Because Akiyoshi teaches compounds with Insecticidal activity, it does not motivate one skilled in that art to make compounds having PPAR activity, and likewise, Sierra does not suggest compounds having insecticidal activity.

Akiyoshi and Sierra do provide any motivation or suggestion to make the claimed compounds and therefore have not established a prima facie case of obviousness. The applicants respectfully request the examiner to withdraw the rejection based on obviousness.

The applicants believe the application is now allowable and respectfully request favorable reconsideration. If any issues remain regarding the allowance of this application, the examiner is respectfully invited to contact the applicants' agent, James Epperson, by phone (203-677-6974), fax (203-677-6900), or e-mail (james.epperson@bms.com).

Respectfully submitted,

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